

REMARKS

This document is filed in reply to the Office Action dated June 16, 2004 ("Office Action"). Applicant has amended claim 14 to promote clarity as suggested by the Examiner and to correct a typographical error. Support for the phrase "a second liver slice obtained and incubated in the same manner as the first liver slice" can be found at, e.g., page 7, lines 9-14 of the specification. No new matter has been introduced.

Claims 1-26 are pending. Among them, claims 1-13 have been withdrawn from further consideration for being drawn to a non-elected invention. Claims 14-26 are now under examination. Reconsideration of this application is requested in view of the following remarks:

The Examiner rejected claims 14-26 for being indefinite. See the Office Action, page 2, lines 13-14. These claims are drawn to a method of evaluating responsiveness of a subject having hepatitis to a drug. The method includes, among others, obtaining a first liver slice and a second liver slice, and incubating them in a medium containing a drug and a medium free of the drug, respectively.

According to the Examiner, "essential steps ... [i.e.,] when and where the second slice of liver is obtained" are "omitted." See the Office Action, page 2, line 14. Note that independent claim 14 clearly recites these "essential steps" for the first liver slice. Applicant has amended this claim to point out that the second liver slice is obtained and incubated in the same manner.

The Examiner also asserted that "what kind of the drug the second slice of liver tissue is not exposed to in the medium" is omitted from claim 14. See the Office Action, page 2, lines 15-16. He kindly suggested inserting "the" before "drug" in this claim. Applicant has made this amendment accordingly.

In view of the above amendments, Applicant submits that claim 14 meets the definiteness requirement. Claims 15-26, dependents from claim 14, further limit the claimed subject matter. For the same reasons, they also meet the definiteness requirement.

Applicant discloses herewith three publications listed on the co-filed form PTO-1449, i.e., (i) Edwards et al., Drug Metabolism and Disposition, 2003 vol. 31, No. 3, 282-288; (ii) Olinga et al., Journal of Hepatology 35 (2001) 187-194; and (iii) Nakamura et al., Journal of Hepatology (300 1999,101-106. None of these three publications teaches or suggests evaluating

Applicant : Chau-Ting Yeh
Serial No. : 10/688,302
Filed : October 15, 2003
Page : 7 of 7

Attorney's Docket No.: 14176-005001

responsiveness of a subject having hepatitis to a drug. Thus, claim 14, as well as its dependents, is novel and nonobvious over the three publications.

CONCLUSION

Applicant submits that grounds for the rejections asserted by the Examiner have been overcome, and that the claims, as amended, define subject matter that is definite, novel, and non-obvious. On this basis, it is submitted that allowance of this application is proper, and early favorable action is solicited.

Please apply any charges to deposit account 06-1050, referencing the Attorney's Docket No. 14176-005001.

Respectfully submitted,

Date: 7-27-04

Y. Rocky Tsao
Y. Rocky Tsao
Attorney for Applicant
Reg. No. 34,053

Fish & Richardson P.C.
225 Franklin Street,
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906